

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 6-15-01

APPL. S.N.: 091766143

TO EXAMINER: P. Patten

ART UNIT: 1651

MOSE MONTGOMERY ROOM 11E18

MAILROOM DATE 6-14-01

AFTER FINAL YES NO NUMBER OF T.D(S). FILED 2

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this Informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE IN LEFT IN FILE.

- The T.D. is PROPER and has been recorded. (See 14.23).
- The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).
- The recording fee of \$\_\_\_\_\_ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)
- Application Examiner has not processed T.D. fee. (See fee authorization).
- The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).
- The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).
- It is directed to a particular claims(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).
- The person who signed the terminal disclaimer:  
 has failed to state his/her capacity to sign for the business entity, (See 14.28).  
 is not recognized as an officer of the assignee, (See 14.29 and possibly 14.29.01).
- No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).
- No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).
- The T.D. is not signed. (See 14.26, 14.26.3). or 14.26.03 if TD is not signed by all the owners.
- Attorney not of record in oath/decl. or a separate paper filed appointing a new or associate attorney. (See 14.29.01).
- The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).
- The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed) is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).
- The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3) (For Samples 14.27.04 and 14.27.05)
- Other: \_\_\_\_\_

Suggestion to request refund of \$\_\_\_\_\_. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALITIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

- Sample of a TD over a pending application and assignee Certificate (See 14.37).  
 Sample of a TD over a prior patent and assignee Certificate (See 14.38).  
 Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Muraleedharan G. Nair, Haibo Wang, Gale M. Strasburg,  
In re application of: Alden M. Booren and James I. Gray

Application No.: 09 /761,143 Group No.: 1651

Filed: 2001 January 16 Examiner: P. Patten

For: METHOD FOR INHIBITING CYCLOOXYGENASE AND INFLAMMATION USING  
CYANIDIN

Patent No.: Issue Date:

Reexamination No.:

\*NOTE: Preferably also insert Inventor's name and invention title.

Assistant Commissioner for Patents  
Washington, D.C. 20231

TERMINAL DISCLAIMER TO OBLVIALE  
A DOUBLE PATENTING REJECTION (37 C.F.R. § 1.321(c))

Identification of Person(s) Making This Disclaimer

Ian C. McLeod

(type or print names of all inventors or assigns or name of attorney signing disclaimer)

(a) represent that I am

- an inventor (applicant) of this invention.
- an assignee of this invention.

WARNING: "If the patent or patent application is assigned to an organization, such as a corporation, partnership, university, [g]overnment agency or similar entity, and the disclaimer is signed by the assignee, the assignee must comply with § 3.73(b)." Notice of Oct. 15, 1993, 1156 O.G. 54-61 at 56, § 1490, M.P.E.P., 7th Edition.

- a representative authorized to sign on behalf of the assignee identified below.

- A statement under 37 C.F.R. § 3.73(b) is attached.

WARNING: See the above "WARNING".

- the attorney of record for this invention.

NOTE: The rules "permit an attorney or agent of record to sign a terminal disclaimer without the need to comply with § 3.73(b)." Notice of Oct. 15, 1993, 1156 O.G. 54-61, at 56. See also § 1490, M.P.E.P., 7th Edition.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. § 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

- deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: 6/14/01

FACSIMILE

transmitted by facsimile to the Patent and Trademark Office, (703) 305 7939

Tammi L. Taylor

Signature  
Tammi L. Taylor  
(type or print name of person certifying)

(Terminal Disclaimer to Obviate a Double Patenting Rejection [3-4]—page 1 of 4)

BEST AVAILABLE COPY

**IDENTITY OF ASSIGNEE AND TITLE OF DISCLAIMANT**  
*(if applicable)*

The assignee is \_\_\_\_\_

Name of assignee \_\_\_\_\_

Address of assignee \_\_\_\_\_

Title of disclaimant authorized to sign on behalf of assignee \_\_\_\_\_

**EXTENT OF DISCLAIMANT'S INTEREST**

The extent of the interest in this invention that the disclaimant owns is in:

- the whole of this invention.  
 a sectional interest in this invention, as follows:

*(state the exact interest of the disclaimant)*

**RECORDAL OF ASSIGNMENT IN PTO**  
*(if applicable)*

- The assignment was recorded on \_\_\_\_\_

Reel \_\_\_\_\_

Frame \_\_\_\_\_

- Authorization for recordal of the assignment is separately attached.  
 A separate  "ASSIGNMENT (DOCUMENT) COVER SHEET" or  
 FORM PTO 1595 is also attached.

**ESTABLISHING RIGHT OF ASSIGNEE TO TAKE ACTION**  
*(if applicable)*

- Attached is a STATEMENT UNDER 37 C.F.R. § 3.73(b) establishing the right  
of the assignee to take action in this case.

NOTE: Insert the appropriate page 3.

(Terminal Disclaimer to Obviate a Double Patenting Rejection [9-4]—page 2 of 4)

**FEE PAYMENT**

- Attached is a  check  money order in the amount of \$ \_\_\_\_\_  
 Authorization is hereby made to charge the amount of \$ 110  
 to Deposit Account No. 13-0610  
 to Credit card as shown on the attached credit card information authorization form PTO-2038.  
WARNING: Credit card information should not be included on this form as it may become public.  
 Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.
- A duplicate of this paper is attached.

BEST AVAILABLE COPY

Date: 06/14/01

Signature of disclaimant



SIGNATURE OF PRACTITIONER OF RECORD

Reg. No.: 20,931

Ian C. McLeod

(type or print name of practitioner)

Customer No.: 21036

2190 Commons Parkway

P.O. Address

Okemos, Michigan 48864

(Terminal Disclaimer to Obviate a Double Patenting Rejection [9-4]—page 4 of 4)

**DISCLAIMER**  
**(Provisional Obviousness-Type Double Patenting Rejection over A Pending Application)**

Petitioner(s) hereby disclaims, except as provided below, the terminal part of any patent granted on the instant application, which would extend beyond the expiration date of any patent granted on Application No. 09 / 749,856, filed on 12/28/00, as shortened by any terminal disclaimer. Petitioner(s) hereby agree(s) that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the above-listed application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

In making the above disclaimer, disclaimant does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154 to 156 and 173 of any patent granted on the application forming the basis of the double patenting rejection, namely, any patent granted on Application No. 09 / 749,856, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

**DISCLAIMER FEE (37 C.F.R. § 1.20(d))**

- Other than a small entity — fee \$110.00
- Small entity — fee \$55.00
  - Small entity statement attached
  - Small entity statement already filed
    - In patent application \_\_\_\_\_ / \_\_\_\_\_  
on \_\_\_\_\_ (Date)

**BEST AVAILABLE COPY**

(Terminal Disclaimer to Obviate a Double Patenting Rejection—(Provisional Obviousness-Type Double Patenting Rejection Over A Pending Application) [9-4]—page 3 of 4)